

Patent Application No. 10/726,387  
Attorney File No. 63833-5028

### Remarks

Applicants have amended claims 1, 5, 7-12, 14-18, 20 and 21, and has added new claims 22 to 33. Initially, Applicants would like to note that the original claims as filed inadvertently skipped the numbering of claim 8. Applicants respectfully request the Examiner to renumber the claims to correct for this typographical error, i.e., please renumber claims 9-33 as 8-32. Applicants now address the issues raised by the Examiner in the above-identified Office action as follows:

#### I. Restriction of Claimed Subject Matter

The Examiner alleges that the subject matter presented in the initially-filed claim set is directed to three different inventions, and has grouped the claims as follows: (1) Group 1 – claims 1 to 13, and 17 to 19 (drawn to a subterranean drill bit and its construction; (2) Group 2 – claims 14 to 16 (drawn to a composite construction); and (3) Group 3 – claims 20 and 21 (drawn to a method of making a composite construction).

#### A. Commonality of Group 1 and 2 Subject Matter

Applicant has amended independent claim 14 to recite a composite construction that is formed by combining granules each having a first and second material phase. Since the composite constructions in both independent claim 1 and claim 14 share the commonality of being formed from such granules having first and second material phases, Applicant submits that the subject matter recited in these claims shares a common utility and, thus should be considered to be within a common scope of invention. In view thereof, Applicant respectfully traverses the Examiner's request for restriction as between the subject matter in Group 1 and Group 2, and respectfully requests that this restriction be reconsidered and withdrawn.

#### B. Commonality of Group 1 & 2 subject matter as compared to that of Group 3

Applicant has amended independent claim 20 to recite a method of making a composite construction using a plurality of granules having first and second phases. Applicant submits that the method as recited in amended claim 20 is used to make the constructions as recited in amended independent claims 1, 7, 14 and 17, and that the construction recited in these independent claim are not made by any other method. For this reason, Applicant respectfully

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traverses the Examiner's request for restriction as between the subject matter in Group 3 and the subject matter in Groups 1 and 2, and respectfully requests that this restriction be reconsidered and withdrawn.

C. Mandatory Election

As noted above, Applicant traverses the Examiner's request for restriction, but presents herewith the required mandatory restriction electing the subject matter of claims 1 to 13, and 17 to 19 identified in Group 1.

II. New Claims

Applicant has added new claims 21 to 32 (as correctly numbered in this Amendment), and submits that the subject matter recited in these claims is properly supported within the specification. In view thereof, Applicant respectfully requests that these new claims be entered and examined on the merits.

III. Conclusion

Applicant respectfully requests that the request for restriction of the subject matter presented in these amended claims be reconsidered and withdrawn, that the newly presented claims be entered, and that all claims pending in this application undergo substantive examination on the merits.

The proceedings herein are for a patent application and the provisions of 37 C.F.R. 1.136 apply. Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

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If any additional fees are necessary for this matter, please charge our Deposit Account  
No. 10-0440.

Respectfully submitted,

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Dated: February 8, 2006

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